

REMARKS

Applicant wishes to thank the Examiner for the consideration given this case to date. Applicant has now had an opportunity to carefully consider the Examiner's action, and respectfully submits that the application, as amended, is now in condition for allowance. As filed, claims 1-74 were pending. With the amendments above, claims 51, 53-64, and 73-80 remain pending.

THE EXAMINER'S ACTION

In the Office Action dated September 12, 2003, the Office:

made final the restriction requirement first made June 2, 2003;

rejected claims 57-60 under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter of the claimed invention;

rejected claims 51, 54, 57, 60, and 64 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No, 3,570,486 to Engelscher et al ("Engelscher '486");

rejected claims 55 and 56 under 35 U.S.C. § 103(a) as being obvious in light of Engelscher '486;

indicated that claims 52, 53, 58, 59 and 61-63 would be allowable if rewritten; and

indicated that claim 73 was allowable as filed.

RESTRICTION REQUIREMENT

Applicant has cancelled claims deemed drawn to a non-elected species.

With respect to the finality of the species restriction, Applicant respectfully requests reconsideration, withdrawal of the requirement, and consideration of the claims in light of both species identified by the Office. In the present case, withdrawal of the restriction requirement is proper to conserve resources of both the Office and Applicant, and to prevent two patents from issuing with identical claims. First, resources will be conserved by consideration of both species in a single application. The Office can, and indeed already has, searched both species.

Applicant argued in the traversal filed 15 July, 2003 that there would be no serious burden to search both species a and b. The Office concluded that this argument was unpersuasive not because the Office was burdened by the search, but instead on the dubious assertion that the independent claim was not generic. Thus, the Office has conceded that there is no burden to search. For this reason alone, the requirement should be withdrawn.

Withdrawal of the requirement will also conserve Applicant's resources. The present application has already been restricted into four groups with the elected group in the case at hand being further divided by the species restriction. The Applicant here is a small entity, a sole inventor. To conserve filing fees, prosecution expenses, issue fees, and maintenance payments, Applicant requests that the Office reconsider and withdraw the restriction requirement over the two species identified.

Second, withdrawal of the requirement will prevent two patents from issuing directed to the same invention. Typically 35 U.S.C. § 101 provides the statutory basis for preventing two patents from issuing on the same invention. However, 35 U.S.C. § 121 prevents an application subject to a restriction requirement from being used against a timely filed divisional application. The MPEP recognizes that the co-existence of these statutes can result in two or more patents issuing on the same invention. Indeed, the nullification of the double patenting rejection caused by 35 U.S.C. § 121 puts a heavy burden on the Office to guard against erroneous requirements for restriction where claims define the same invention. MPEP 804.01. The benefits of 35 U.S.C. § 121, however, are only available where the Office has made and maintained a requirement for restriction.

In the present case, the Office has taken the position that the species are patentably distinct. Office Action dated June 2, 2003, numbered paragraph 6. Should the restriction requirement be maintained, Applicant would be entitled to file a divisional application claiming the unelected species, with the same claims drawn to the species which the Office has characterized as patentably distinct. This application would be shielded from a double patenting rejection by 35 U.S.C. § 121. On the other hand, should the Office withdraw the requirement, Applicant will no longer be sheltered by 35 U.S.C. § 121. To be sure, both species would be covered by the claims of the present application, but the Office would have restored the remedy

of a double patenting rejection to prevent further claims to the same invention. The burden on the Office to prevent multiple patents for the same invention obligates withdrawal of the restriction requirement in the present case.

Because withdrawal will conserve the resources of both the Office and the Applicant, and because the Office has the obligation to prevent multiple patents for the same invention, reconsideration and withdrawal of the restriction requirement is respectfully requested.

REJECTIONS UNDER 35 U.S.C. § 112, SECOND PARAGRAPH

Applicant has amended the claims as noted above and believes the rejection under 35 U.S.C. § 112, second paragraph, has been overcome. Re-consideration and withdraw of the rejection in light of the amendments above is respectfully requested.

REJECTIONS UNDER 35 U.S.C. § 102(b)

The Office has rejected claims 51, 54, 57, 60, and 64 under 35 U.S.C. § 102(b) as being anticipated by Engelsher '486. Applicant respectfully submits that this rejection is improper and should be withdrawn. Specifically, Applicant notes that Engelsher '486 does not teach each and every limitation called for by the rejected claims.

For example, claim 51, as amended, calls for "a second hollow body ... having a second fluid access port in fluid communication with the interior of the second hollow body and in fluid communication with the first fluid access port, and an outlet port in fluid communication with the interior of the second hollow body...."

Engelsher '486, on the other hand fails to teach or fairly disclose a second hollow body having both a fluid access port and an outlet port in fluid communication with the interior of the second hollow body.

Claim 57, as amended, calls for "at least one compartment containing the pharmacological agent, where the interior of the compartment is separated from the interior of the second hollow body...."

Engelsher '486, in the most favorable light, may be seen as disclosing a single hollow body or a single compartment - not both. Lacking this, there is no fair reading that can ascribe to Engelsher an interior of the compartment separated from the interior of the second hollow body.

Claim 60, as amended, calls for "a compartmental plunger slidably disposed within the compartment for breaching the barrier, wherein when the compartmental plunger is actuated, the barrier is breached...."

Engelsher '486 lacking a "compartment," also lacks the plunger disposed within the compartment.

Claim 64 calls for "the second hollow body is disposed within the interior of the first hollow body; the first hollow body and second hollow body are substantially longitudinally coaxial; the outlet orifice is disposed in close proximity to the flow orifice; and the flow orifice is adaptable to a cerebrospinal fluid drainage system."

Applicant was unable to find any recitation in Engelsher '486 of suitable adaptations for any "flow orifice" especially one adapted to a "a cerebrospinal fluid drainage system."

Moreover, in Engelsher '486 cannot be said to show or teach an outlet orifice disposed in close proximity to a flow orifice.

For the reasons above, Applicant respectfully requests reconsideration and withdrawal of the rejection under 35 U.S.C. § 102 (b). Should the Office maintain the rejections, Applicant requests an exact indication of particular elements or teachings relied upon in the primary reference.

REJECTIONS UNDER 35 U.S.C. § 103(a)

The Office has rejected claims 55 and 56 under 35 U.S.C. § 103(a) as being obvious in light of Engelsher '486 alone. Applicant respectfully submits that this rejection is improper and should be withdrawn. Specifically, Applicant notes that there is no motivation in Engelsher '486 to make the combinations suggested by the Office.

NEW CLAIMS

Applicant asserts that the new claims 75-80 contain elements that have been searched and are believed to be patentable over the art of record. The new claims are all believed to be readable on the elected group and species.

CONCLUSION

For the foregoing reasons, Applicant respectfully asserts that the case is now in a condition for allowance. While no additional fees are believed due, the Commissioner is hereby authorized to charge any necessary additional fees, or credit any overpayment, to Deposit Account No. 02-2051, referencing Attorney Docket No. 26998-2.

Respectfully submitted,

Dated: 12 March 2004

By:



W. Scott Harders
Registration No. 42,629

BENESCH, FRIEDLANDER,
COPLAN & ARONOFF, LLP
2300 BP Tower
200 Public Square
Cleveland, OH 44114-2378
(216) 363-4443